

## REMARKS

### Summary of the Office Action

In the Office Action, claims 1, 3-5, and 7-8 are pending.

Claims 1, 3-5, and 7-8 are rejected under 35 U.S.C. § 103(a).

Claims 1, 3-5 and 7 are rejected under 35 U.S.C. § 112, second paragraph.

### Applicants' Response

In this Amendment and Response, Applicants address the Examiner's rejections.

Applicants' silence with regard to the Examiner's rejections of the dependent claims constitutes recognition by the Applicants that the rejections are moot based on Applicants' Remarks relative to the independent claim from which the dependent claims depend. Applicants respectfully traverse all rejections of record. Claims 1 and 5 have been amended to clarify the claimed subject matter. Support for these amendments can be found throughout the Specification. (*See, e.g.,* Paragraphs [0017] and [0029]). As such, no new matter has been added. This amendment is made solely to expedite prosecution and does not constitute acquiescence to any of the Examiner's objections or rejections. Applicants reserve the option to further prosecute the same or similar claims in a subsequent application. Upon entry of the Amendment, claims 1, 3-5, and 7-8 are pending. Applicants respectfully submit that all pending claims, as amended, are in condition for allowance over the cited prior art.

### Claim Rejections – 35 U.S.C. § 112, second paragraph

Claims 1, 3-5 and 7 are rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. Applicants have amended independent claims 1 and 5 to more clearly reflect the claimed subject matter. As such, Applicants respectfully request that the Examiner withdraw these rejections of record.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 1, 3-5, and 7 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,786,400 to Buccì (“Buccì”) in view of U.S. Patent No. 5,937,396 to Konya (“Konya”), U.S. Patent Application Publication No. 2002/0083011 to Kobayashi (“Kobayashi”), and further in view of “Official Notice” (as evidenced by *in re Venner*, 262 F.2d 91 (1998)). Claims 4 and 8 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Buccì in view of Konya, Kobayashi, “Official Notice,” and further in view of U.S. Patent No. 6,353,811 to Weissman (“Weissman”).

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. Using the Supreme Court’s guidelines enunciated in *Graham v. John Deere*, 383 U.S. 1, 17 (1966), one determines “obviousness” as follows:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

In *KSR Int’l Co. v. Teleflex Inc.*, No. 04-1350 (U.S. April 30, 2007), the Supreme Court reaffirmed the *Graham* test, and indicated that although it should not be rigidly applied, a useful test for determining obviousness is to consider whether there is a teaching, suggestion or motivation in the prior art that would lead one of ordinary skill in the art to combine known elements of the prior art to arrive at the claimed invention. Importantly, the Court emphasized that a patent examiner’s analysis under § 103 should be made explicit in order to facilitate review.

Thus, to establish a *prima facie* case of obviousness, the Examiner has an obligation to construe the scope of the prior art, identify the differences between the claims and the prior art,

and determine the level of skill in the pertinent art at the time of the invention. The Examiner must then provide: (1) an explicit, cogent reason based on the foregoing why it would be obvious to modify the prior art to arrive at the claimed invention; (2) a reasonable expectation of success; and (3) a teaching or suggestion of all claimed features. See M.P.E.P. §§ 706.02(j) and 2143.

Claim 1 is directed to a financial transaction payment system. Among other things, claim 1 features a consumer depository account maintained by a first financial institution holding funds on behalf of said consumer, a credit payment card for conducting two or more transactions and incurring charges associated with each such transaction, said card being issued to said consumer by a second financial institution, said card further being linked to said depository account maintained at said first institution for covering said charges, and a credit card balance reflecting a spending limit associated with said credit card, wherein at least a portion of said charges accumulated using said credit payment card during a are deducted automatically from said depository account on a periodic cycle corresponding to a user-determined deduction cycle and applied to said credit card balance.

#### No Motivation to Combine

As an initial matter, Buccì is directed to a system and method that offers a consumer the option to conduct transactions using either a credit line or funds in a depository account. (*See Buccì, Abstract*). In contrast, Konya describes a system for immediately transferring currency between ATM accounts. (*See Konya, Abstract*). Kobayashi describes a transaction mediation system. (*See Kobayashi, Abstract*). The three cited references are concerned with solving different problems, and there would be no reason or likelihood of success for one of ordinary skill to combine the teachings of Buccì with the teachings of either Konya or Kobayashi. The Examiner has not established a prima facie case of obviousness for at least these reasons.

Independent Claims 1 and 5

Assuming, *arguendo*, that there was a motivation to combine Bucci, Konya, Kobayashi, and “Official Notice,” there would be no reasonable expectation of success and the combination would fail to disclose or suggest all elements of amended claim 1.

Bucci describes a system that allows consumers to use a single card to conduct transactions using either a credit line or funds in a deposit account. (*See* Bucci, Abstract, col. 2, lines 1-11). The cited portions of Bucci describe a system in which the consumer can “conduct at least one transaction at a point-of-sale using money withdrawn from an account associated with the first financial institution or a second financial institution, if the consumer selects a debit option at a point-of-sale terminal, and to conduct at least one other transaction at a point-of-sale using a line of credit issued by the first financial institution or the second financial institution, if the consumer selects a credit option at the point-of-sale terminal...” (Bucci, col. 2, lines 6-14). Bucci further describes, “[w]here the accounts reside in multiple financial institutions, the consumer would have to provide appropriate information to the institutions that issues the card to allow that issuer to retrieve funds from the other financial institution.” (Bucci, col. 4, lines 20-23 and *See* Figure 3). While Bucci does describe a single card associated with multiple financial institutions, it fails to disclose or suggest a credit payment card issued to a consumer by a financial institution for conducting transactions and incurring charges associated with each such transaction, wherein the card is linked to said depository account maintained at a *different institution* for covering said charges and wherein at least a portion of said charges accumulated using said credit payment card during a user-determined deduction cycle are deducted automatically from the depository account maintained at the non-credit card issuing institution

periodically, as featured in claim 1. While the cited portion of Bucci relates to withdrawing funds associated with debit purchases, there is no suggestion or disclosure of deducting funds on a user-determined deduction cycle from an account maintained at the non-credit-card issuing institution at all. Regarding an exemplary transaction using the described system, Bucci further describes, “[a]t POS terminal 305 at least two options are displayed to the consumer. The two options are debit option 310 and credit option 315, as shown in FIG 3. The consumer then decides whether the consumer wants the transaction amount to be withdrawn from checking account 350 at financial institution 345 or added to a credit line of balance of credit account 340 at financial institution 330.” (Bucci, col. 5, lines 44-51). The debit and credit accounts described in Bucci are maintained at different financial institutions and the consumer gets to decide whether to use the debit card associated with the first institution or the credit card associated with the second institution at the time of purchase. Nowhere, however, does Bucci disclose or suggest a credit payment card issued to a consumer by a financial institution for conducting transactions and incurring charges associated with each such transaction, wherein the card is linked to said depository account maintained at a different institution for covering said charges and wherein at least a portion of said charges accumulated using said credit payment card during a user-determined deduction cycle are deducted automatically from the depository account maintained at the non-credit card issuing institution periodically, as featured in claim 1.

The Examiner alleges that the method described in Konya teaches that the amount of a transaction is deducted from a depository account. Konya is directed to a system for transferring money between accounts that allows currency to be immediately transferred from a first account to an ATM. (*See*, Konya, Abstract). Assuming, *arguendo*, that Konya describes deducting the

amount of a transaction from a depository account, it still fails to overcome the deficiencies of Buccì described above with respect to independent claim 1.

The Examiner further alleges that Kobayashi teaches deducting a transaction amount from the bank account of a purchaser on a monthly or transactional basis. The cited portion of Kobayashi describes using conventional methods to withdraw money from an account, and assuming, *arguendo*, that Kobayashi teaches deducting a transaction amount from the bank account of a purchaser on a monthly or transactional basis, it also fails to overcome the deficiencies of Buccì described above with respect to independent claim 1. (*See* Kobayashi, paragraph [0130])

Finally, the Examiner also cites “Official Notice,” but like Konya and Kobayashi, “Official Notice” also fails to overcome the deficiencies of Buccì described above with respect to independent claim 1.

For at least these reasons, Applicants respectfully submit that claim 1 as amended is non-obvious and patentable over Buccì in view of Konya, Kobayashi, and “Official Notice.” Amended independent claim 5 contains similar features to those recited in independent claim 1 and should be allowed for at least these same reasons.

#### Claims 3 and 7

Claims 3 and 7 depend from independent claims 1 and 5. As such, Applicants respectfully submit that these claims are also allowable.

#### Dependent Claims 4 and 8

The Examiner alleges that, “Weissman teaches billing means operated by said second financial institution for periodically informing said consumer of said charges made on the card and of the amount received from said consumer depository account to cover said charges...”

(Office Action, page 4). Assuming, *arguendo*, that this is the case, Weissman does not disclose or suggest the features of independent claims 1 and 5 discussed above and fails to make up for the deficiencies of Bucci, Konya, Kobayashi, and “Official Notice” with respect to these claims. Therefore, claims 4 and 8, which depend from independent claims 1 and 5 respectively, are also allowable for at least the reasons given above with respect to independent claims 1 and 5.

Based on the foregoing amendments and remarks, Applicants respectfully submit that the pending claims are in condition for allowance and that the Examiner’s rejection of claims 1, 3-5 and 7 under 35 U.S.C. § 112, second paragraph and of claims 1, 3-5, and 7-8 under 35 U.S.C. § 103 should be withdrawn.

**CONCLUSION**

On the basis of the foregoing amendments and remarks, Applicants respectfully submit that the pending claims of the present application are allowable over the prior art of record. Applicants thus respectfully request that the pending claims be allowed by the Examiner. Favorable consideration and timely allowance of this application are respectfully requested. In the event that the application is not deemed in condition for allowance, the Examiner is invited to contact Robert Maier at (212) 408-2538 in an effort to advance the prosecution of this application.

Respectfully submitted,



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